

REMARKS

Applicant has amended claims 6 and 7 to place them in independent form without changing their scope of coverage. Applicant has added claim 56, which was intended to have been added in the prior response filed January 10, 2003, but the text of this claim did not appear in the prior response due to an inadvertent error.¹ Claims 1-57 are pending.

Applicant appreciates the Examiner's indication that claims 6-8 and 50 contain allowable subject matter. As explained above, Applicant has placed claims 6 and 7 in independent form. Accordingly, claims 6-8 and 50 are in condition for immediate allowance.

In the Office Action, claims 1-5, 9-49, and 51-57 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,009,881 to Baudin ("Baudin") in view of EP 0 943 260 ("EP 260").

Baudin discloses an applicator device for a hair product designed for use in dying newly-grown roots of hair adjacent to the scalp. When an individual dyes her hair, newly-grown hair roots will emerge in the individual's natural hair color, while the remainder of the hair will be in the dyed color. Such newly-grown hair roots need to be dyed so that they conform to a dyed color. (Baudin at col. 1, ll. 14-20.) Baudin provides "a device that allows the user, in a single movement, to spread the hair on either side of a part, apply the product and spread it on the base of the hair [i.e., the newly-grown hair roots]." (Baudin at col. 1, ll. 59-62.)

¹ Applicant notes that the Office Action indicates that claim 56 was examined and rejected even though its text does not appear in the last response.

To accomplish this objective, Baudin discloses an applicator device that comprises, *inter alia*, a first means "for separating hair on either side of a part in a user's hair," a second means "for applying the product in the vicinity of the part," and a third means "for spreading the applied product on the base of the hair situated on either side of the part." (Baudin at col. 2, ll. 1-7.) Baudin further discloses that the functions of the first, second, and third means are advantageously achieved via different parts of the device:

The functions of separation, application and spreading are advantageously performed by separate parts of the device. The fact that the three means are separate makes it possible to produce an inexpensive device that is simple to manufacture, e.g., by molding. To combine two or more functions in one means would present the problem of not offering sufficient flexibility in the choice of characteristics either of separation of the hair, application of the product or spreading.

(Baudin at col. 2, ll. 33-41.)

Referring to Fig. 1A of Baudin, the applicator assembly 100 comprises a receptacle 101 with a device 1 mounted thereon. The device 1 is force-fit onto a cylindrical straight part 106 of an applicator end-piece 105, which engages a neck 104 of the receptacle 101. (Baudin at col. 5, ll. 10-41.) The end 4 of the device 1 corresponds to the separation means; the applicator end-piece 105 corresponds to the application means; and the free edge of the wall 3 of the device 1 corresponds to the spreading means. (Baudin at col. 5, ll. 46-49.)

Unlike Baudin, EP '260 discloses an applicator having a plurality of shaped fingers with dispensing holes spaced along the fingers, which are designed for both dispensing and spreading a product. (Derwent Abstract.) The fingers are mounted on a

handgrip including a reservoir for holding a product to be applied. (*Id.*) The fingers are made from an elastic material. (*Id.*)

The Examiner has acknowledged that Baudin fails to disclose a "plurality of teeth being formed of an elastically deformable material," as recited in the claims, but has asserted that it would have been obvious to modify Baudin to include these features in view of EP '260. More particularly, the Examiner has asserted that a portion 109 of the applicator end-piece 105 of Baudin (i.e., the application means) corresponds to one of the recited teeth and that EP '260 suggests modifying Baudin to have a plurality of portions 109 made of an elastically deformable material. (Office Action at 3.)

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a) based on multiple references, the Examiner must show the following: (1) there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine teachings of the references; (2) there is a reasonable expectation or success; and (3) the teaching or suggestion to make the claimed combination and the reasonable expectation of success are both found in the prior art and not based on applicant's disclosure. See MPEP § 2142. The Examiner's rejection fails to satisfy these criteria.

As an initial matter, there is no motivation or suggestion to modify Baudin to have the portion 109 (i.e., the part allegedly corresponding to one of the claimed teeth) made of an elastically deformable material. Unlike the fingers disclosed in EP '260, the portion 109 of Baudin does not separate hair or spread dye around the hair. The portion 109 serves only to dispense the dye to the hair root, while other components separate the hair and spread the dye. (Baudin at col. 2, ll. 33-41.) As shown in Fig. 1A,

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the portion 109 is recessed from the edge 9 of the wall 3 so as to minimize contact with the scalp. Since contact of the portion 109 with the scalp is minimized, one of ordinary skill would not be motivated to make it from an elastically deformable material to provide "a softness to the user's scalp," as asserted in the Office Action. (Office Action at 3.)

Additionally, there is no motivation or suggestion to modify Baudin to include multiple portions 109. Baudin discloses a single portion 109 for precisely applying dye to the hair roots at the base of the scalp by parting a particular portion of the hair with a completely different "separation" component. (See, e.g., Baudin at col. 5, ll. 51-65.) The "separation" component and the "application" component work together to apply the dye to the hair roots of the parted portion. EP '260 dissimilarly teaches a single component (i.e., the fingers) to both separate the hair and apply the product. One of ordinary skill in the art would not modify Baudin to include an additional portion 109 since the resulting device would lack a separate component, associated with the additional portion 109, to separate the hair prior to applying the dye. The "separation" component disclosed in Baudin would not part hair at two separate locations, as would be required by the Examiner's hypothetical combination. Thus, in view of Baudin's teaching to use different components for separating the hair and applying the dye, one of ordinary skill in the art would not modify Baudin to include multiple portions 109 in view of EP '260.

Furthermore, Baudin and EP '260 disclose teachings that are completely incompatible with one another. As explained above, Baudin discloses an applicator that has separate means for separating hair, applying the dye, and spreading the dye, while EP '260 discloses a device that uses a single component—the fingers—to dispense and

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spread product throughout the hair. Moreover, unlike the portion 109 of Baudin, the fingers of EP '260 appear to be configured to direct product all over the hair, not just to the hair roots, as disclosed in Baudin. Thus, the fingers disclosed in EP '260 are incompatible with the applicator design objectives of Baudin.

For at least these reasons, one of ordinary skill in the art would not have had any suggestion or motivation to modify Baudin in view of EP '260 to arrive at the invention recited in claims 1-5, 9-49, and 51-57.

With respect to claim 20, the cited references fail to teach or suggest an application member, wherein "the at least one wall extends from a substantially planar surface of the base portion, in a direction substantially perpendicular thereto," as recited in claim 20. Accordingly, claim 20 is allowable for this additional reason.

Regarding claim 35, the cited references fail to teach or suggest an application member, wherein "the support is curved along at least a portion of a length thereof," as recited in this claim. Accordingly, claim 35 is allowable for this additional reason.

With respect to claim 37, the cited references fail to teach or suggest an application member, wherein "a longitudinal axis of at least one of the plurality of teeth is not parallel to a longitudinal axis of the reservoir when the application member, the support, and the reservoir are coupled together," as recited in this claim. Accordingly, claim 37 is allowable for this additional reason.

Regarding claim 51, the cited references fail to teach or suggest an application member, comprising "a wall extending from a surface of the base portion in a direction substantially perpendicular to the base portion," as recited in this claim. Accordingly, claim 51 is allowable for this additional reason.

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Applicant respectfully requests reconsideration of this application, withdrawal of the claim rejection, and the timely allowance of the pending claims.

The Office Action contains numerous assertions regarding the claims and the related art. Applicant declines to subscribe automatically to any of those assertions.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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